

Application No.: 10/826,869
Office Action Dated: July 24, 2006
Response to Office Action Dated: August 11, 2006

REMARKS

Claims 1-15 and 42 are pending and remain for consideration.

Claims 1-7, 10-15, 41 and 42 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Beane et al. (U.S. Pat. Appl. Publ. No. 2002/0022762). The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Beane et al. is directed to a lens warming and cleaning device for use with an optical surgical instrument. The device includes a heat-conducting tube sized and shaped to receive the lens portion of the instrument, a heating element thermally coupled to an exterior of the tube, and a cleaning member disposed within the tube. The cleaning member is disposed such that when the lens portion of the instrument is inserted into the tube, the lens portion contacts the cleaning member.

Beane et al. does not teach or suggest a sterile apparatus to protect endoscopes wherein the apparatus includes a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact defogging material and to prevent the defogging material from spilling out of the canal, as is generally recited in independent claim 1 and incorporated in dependent claims 2-7, 10-15 and 42. This is not surprising since Beane et al. teaches a saline solution retained in a sponge.

In support of the rejection, the Examiner states:

However, Beane et al. disclose the device wherein the distal end 124 is attached to bottle 118, and proximal end 122 is attached to a stem 126 on housing 112. Distal end attaches to bottle 118 via complementary screw threadings 128 (inside tube 114) and 130 (on bottle 118). Alternatively, bottle 118 and distal end 124 can be attached by an interference or press fit, using, e.g., an O-ring. Proximal end 122 is similarly attached to stem 126 using, e.g., complementary screw threadings, an insert mold, or an interference fit (see

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paragraph 0053). The interference or press fitting is configured to allow the endoscope to enter the canal and make contact with the defogging material and further prevents spillage of the material out of the canal, thus meeting the limitations of claim 1.

We do not understand and therefore disagree with the Examiner's grounds of rejection. The interference or press fit referred to by the Examiner merely has to do with how the walls of the bottle 118 and the tube 114 are attached to one another at a distal end 124 of the tube 114, and how the walls of the tube 114 and the housing 112 are attached at a proximal end 122 of the tube 114. The interference or press fit has nothing to do with teaching a mechanism disposed within the tube 114 which would self-seal so as to obstruct and prevent fluid from spilling out of the tube. This is not surprising because Beane et al. does not need a self-sealing mechanism. The solution of Beane et al. is retained in a sponge. The published present application at paragraph [0020] lists examples of self-sealing mechanisms as, for example, a tube within a tube mechanism, valves including those resembling a heart valve or a valve in a human vein, a flap and hinge valve which opens only in one direction, and a ball and socket mechanism.

For an anticipation rejection to be appropriate, each and every element or limitation in a rejected claim must be shown in a single prior art reference used in the claim rejection. Because Beane et al. does not teach or suggest a sterile apparatus to protect endoscopes wherein the apparatus includes a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact defogging material and to prevent the defogging material from spilling out of the canal, as is generally recited in independent claim 1, it cannot be maintained that Beane et al. anticipates claim 1. Moreover, because claims 2-7, 10-15 and 42 each ultimately depend from and thereby incorporate the limitations of claim 1, these dependent claims are not anticipated by Beane et al. for at least the reasons

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set forth for claim 1.

Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beane et al. (U.S. Pat. Appl. Publ. No. 2002/0022762) in view of Dohm et al. (U.S. Pat. No. 5,720,391). The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Dohm et al. is directed to packaging and a holder provided for a heart valve prosthesis. The holder is adapted to grasp the heart valve prosthesis and includes a post. The packaging includes a collar for holding the post of the holder. An inner tray of the packaging receives the collar such that the prosthesis is suspended within the inner tray. An outer tray receives the inner tray. An inner tray lid seals the inner tray and an outer tray lid seals the outer tray.

The Examiner apparently cites Dohm et al. for mentioning that Styrofoam can be used for a transportation case for medical instruments. However, claim 8 ultimately depends from and thereby incorporates the limitations of claim 1. It has been demonstrated above that Beane et al. contains insufficient teaching to anticipate claim 1. It therefore follows that Beane et al. also contains insufficient teaching when taken either alone or in combination with Dohm et al. to render claim 8 obvious.

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beane et al. (U.S. Pat. Appl. Publ. No. 2002/0022762) in view of Lantz (U.S. Pat. No. 6,910,582). The rejection is traversed and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Lantz is directed to a shock absorbing insulated shipping container including an external corrugated cardboard box, receiving an insulated body having a cavity for holding breakable glass bottles. The bottles may contain a high value liquid product being shipped, such as medicine or wine. The container also receives an especially configured and constructed, shock-absorbing filling structure or partition system for separating the glass bottles from one another, and from one or more

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receptacle cavities for holding phase change coolant or temperature control material in a predetermined relationship to the glass bottles. The container also includes an insulating and cushioning cover adapted to engage into a top opening of the insulated body after the bottles and coolant are received in the cavity thereof. The insulated body is formed from injection molded polyurethane, wrapped in a plastic film.

The Examiner apparently cites Lantz for mentioning that gel can be used for a transportation case for cushioning. However, claim 9 ultimately depends from and thereby incorporates the limitations of claim 1. It has been demonstrated above that Beane et al. contains insufficient teaching to anticipate claim 1. It therefore follows that Beane et al. also contains insufficient teaching when taken either alone or in combination with Lantz to render claim 9 obvious.

In view of the foregoing, it is respectfully submitted that claims 1-15 and 42 are in condition for allowance. All issues raised by the Examiner having been addressed, an early action to that effect is earnestly solicited.

No fees or deficiencies in fees are believed to be owed. However, authorization is hereby given to charge our Deposit Account No. 13-0235 in the event any such fees are owed.

Respectfully submitted,

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